

REMARKS

Please reconsider the application in view of the above amendments and the following remarks. Applicant thanks the Examiner for carefully considering this reply.

Disposition of Claims

Claims 1-10 were pending in this application. Claims 11 and 12 have been added by way of this reply and are also currently pending. Claims 1 and 9 are independent. The remaining claims depend, directly or indirectly, from independent claims 1 and 9.

Claim Amendments

Claims 1-5 and 8-10 have been amended to clarify embodiments of the invention. Applicant respectfully asserts that no new matter has been introduced by way of these amendments, as support for the amendments may be found, for example, in Fig. 3 and paragraphs [0019]-[0024], [0037]-[0043], and [0072] of the originally-filed application and claims. As such, Applicant submits that these amendments do not necessitate a new search.

Claim Objections

Claims 1, 5, and 8 were objected to because the language “tamper resistant module” was held by the Examiner to convey a desired effect of the module rather than a specific type. The pending claims have been amended by way of this reply to specify, in part, a smart card in place of a tamper resistant module. Accordingly, withdrawal of this objection is respectfully requested.

Claim 8 was further objected to as being in improper form because a multiple dependent claim cannot depend from another multiple dependent claim. Claim 8 has been amended by way of this reply so that the claim is no longer a multiple dependent claim. Accordingly, withdrawal of this objection is respectfully requested.

Claim 10 was objected to as being in improper form because a multiple dependent claim should refer to other claims in the alternative only. Claim 10 has been amended by way of this reply so that the claim is no longer a multiple dependent claim. Accordingly, withdrawal of this objection is respectfully requested.

Rejections under 35 U.S.C. § 101

Claim 10 stands rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Specifically, the Examiner asserts that claim 10 is software per se and therefore does not claim the necessary physical articles or objects to constitute a machine or manufacture within the meaning of 35 U.S.C. § 101. This rejection is respectfully traversed.

Amended claim 10 is directed to computer program that includes instructions to perform the method of claim 1 when executed on a smart card (*i.e.*, a physical device), wherein the computer program is stored on a smart card. Accordingly, amended claim 10, is analogous to a “computer readable medium” claim, which has been found to be directed to statutory subject matter, see e.g., *In re Beauregard*, *In re Bo Li*. Accordingly, withdrawal of this rejection is respectfully requested.

Rejections under 35 U.S.C. § 112

Claims 1 and 9 are rejected under 35 U.S.C. § 112 second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicant regards as the invention. Specifically, the Examiner asserts that the limitation “counter is used to prove the amount of data flow” renders the claims vague and indefinite. Claims 1 and 9 have been amended by way of this reply to instead recite “counter is used to determine a service fee for use of said service” and are therefore not vague under the rationale provided by the Examiner in paragraph 15 of the Office Action (*i.e.* how is the amount of data flow proved from the counter). Accordingly, withdrawal of the rejection is respectfully requested.

Rejections under 35 U.S.C. § 102

“A claim is anticipated only if *each and every element* as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987) (emphasis added). Further, “[t]he identical invention must be shown in as complete detail as is contained in the claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989).

“[U]nless a reference discloses within the four corners of the document not only all of the limitations claimed but also all of the limitations arranged or combined in the same way as recited in the claim, it cannot be said to prove prior invention of the thing claimed, and, thus, cannot anticipate under 35 U.S.C. § 102.” *Net MoneyIN, Inc. v. VeriSign, Inc.*, 2008 WL 4614511 (Fed. Cir. 2008).

Claims 1, 2, 6, and 9 are rejected under 35 U.S.C. § 102(b) as being anticipated by WO 02/47356 (“Andreaux”). To the extent that this rejection may still apply to the amended claims, this rejection is respectfully traversed.

Independent claim 1 is directed to a method for monitoring the usage of a service by a communications device coupled to a smart card. Specifically, independent claim 1 recites, in part, “a counting step, in which a memory location stores a count of occurrences of decryption steps of said first key attached to a same service” (hereinafter, the counting step) and “a using step, in which said counter is used to determine a service fee for use of said service” (hereinafter, the using step).

The Examiner relies upon Andreaux to disclose all the limitations of independent claim 1. However, Andreaux does not disclose, at least, the limitations of either the counting step or the using step recited above. For example, in relying upon Andreaux to disclose the count step, the Examiner cites to a counter that is decremented each time a key is sent from a source entity to a receiver entity. *See* page 7 of the Office Action (citing Andreaux: page 8 lines 12-20). However, Applicant asserts that whether or not the key is ever used by the receiver entity to decrypt a scrambled data signal is ultimately predicated on whether the receiver entity is able to properly authenticate the source entity. *See* Andreaux: page 6 line 20 – page 7 line 15. Because the steps of key transfer and source entity authentication are two independent events (see Andreaux: page 6 lines 17-23), Applicant suggests that though a key may be sent by the source (*i.e.*, resulting in a decrement to the counter) this does not necessarily mean that the receiver will be able to successfully authenticate the source. Further, if source authentication is unsuccessful then the receiver entity does not perform the decryption of the scrambled data. As such, the counter, which merely tracks the number of times a key has been sent, cannot necessarily serve as a reliable (or

accurate) indicator of the number of times a decryption is performed using the key. For at least that reason, Applicant asserts that the counter disclosed by Andreaux and relied upon by the Examiner in making the rejection cannot be properly equated to the counter used in the counting step of independent claim 1.

Further, in relying upon Andreaux to disclose the using step, the Examiner cites to use of the aforementioned counter (*i.e.*, a counter that is decremented each time a key is sent from a source entity to a receiver entity, page 7 of the Office Action – citing to Andreaux: page 8 lines 12-20). However, according to Andreaux (*i.e.*, page 8 lines 12-20) and according to Examiner's own admission in making the rejection (*i.e.*, see item *b* of claim 1 discussion on page 7 of Office Action), the counter "is used to verify number of times to the content can be transmitted." Andreaux does not contemplate using the counter to determine a service fee for use of a service. Rather, at best, Andreaux contemplates broadcasting content in a digital network while making unauthorized copying impermissible. *See* Andreaux: page 2 line 10. As such, Andreaux is concerned with access and limiting the number of times a particular content is transmitted. *See* Andreaux: page 2 lines 32-38; page 8 lines 12-20. Accordingly, Andreaux does not contemplate use of a counter to determine a service fee for use of a service. For at least that reason, Applicant asserts that the counter disclosed by Andreaux and relied upon by the Examiner in making the rejection cannot be properly construed as the counter used in the using step of independent claim 1.

In view of the above, Andreaux does not disclose the counting step or the using step recited by amended independent claim 1. As such, because Andreaux does not anticipate each and every feature of the claim, amended independent claim 1 is therefore patentable over Andreaux. Amended independent claim 9 recites the same or similar patentable features as amended

independent claim 1 and is therefore patentable over Andreaux for at least the same reasons. Accordingly, withdrawal of this rejection is respectfully requested.

In addition, in view of *Net MoneyIN, Inc. v. VeriSign, Inc.*, all of the features cited to by the Examiner in making the rejection must necessarily be arranged or combined in the same way as recited in the claim. Turning to the 35 U.S.C. § 102 rejection of the Office Action, Applicant asserts that the Examiner has not made a proper rejection in view of *Net MoneyIN, Inc.* For example, independent claim 1 plainly requires, in part, a smart card. In citing to a use of a smart card, the Examiner references a second embodiment of the invention disclosed by Andreaux. See page 6 of the Office Action (citing Andreaux: page 8, line 20 and onwards). However, in other parts of the very same rejection (i.e., page 7 of the Office Action in reference to the counting and using steps), the Examiner also cites to a first embodiment of the invention which, upon a close reading of the Andreaux specification, does not disclose use of a smart card. As such, Applicants assert that the Examiner has not made a proper rejection under the holding of *Net MoneyIN, Inc.* as the Examiner is selecting features from the prior art that are not combined in the same manner as recited in the claims. Accordingly, for this additional reason the rejection is improper and withdrawal is respectfully requested.

Rejections under 35 U.S.C. § 103

MPEP §2143 states that “[t]he key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious.” The Supreme Court in *KSR International Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1739, 75 U.S.L.W. 4289

(2007) noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. *See*, MPEP §2143.

In particular, the Examiner “must articulate the following: (1) a finding that the prior art included each element claimed, although not necessarily in a single prior art reference, with the only difference between the claimed invention and the prior art being the lack of actual combination of the elements in a single prior art reference; ...” MPEP § 2143(A). Applicant asserts that the prior art, whether viewed separately or in combination, fails to teach or suggest all the limitations of the pending independent claims.

Claims 3, 4, 5, 7, and 8

Claims 3, 4,¹ 5, 7, and 8² are rejected under 35 U.S.C. § 103(a) as being unpatentable over Andreaux in view of U.S. Patent Application No. 2002/0048367 (“Maillard”). To the extent that this rejection may still apply to the amended claims, this rejection is respectfully traversed.

As previously discussed, Andreaux does not disclose or render obvious all the limitations of amended independent claim 1. Further, Maillard fails to provide that which Andreaux lacks. For example, Maillard does not disclose or render obvious a “using step” where a counter is used to determine a service fee for use of said service. Rather Maillard, at best, provides a counter which confirms that content is not viewed any more than a predetermined number of times. *See* Maillard: paragraph [0072]. Because a decrementing counter used in restricting viewership is not the same as

¹ Applicant notes that while claim 4 is listed in this rejection, the Examiner has not provided any basis for the rejection of claim 4. Accordingly, this rejection is improper with respect to claim 4 and withdrawal is respectfully requested.

² Applicant notes that while claim 8 is listed in this rejection, the Examiner has not provided any basis for the rejection of claim 8. Accordingly, this rejection is improper with respect to claim 8 and withdrawal is respectfully requested.

a counter used to determine a service fee for a service, the Applicant asserts that Maillard does disclose or render obvious that which Andreaux lacks.

In view of the above, amended independent claim 1 is patentable over Andreaux and Maillard. Further, dependent claims are patentable for at least the same reasons. Accordingly, withdrawal of this rejection is respectfully requested.

Claims 4

Claim 4 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Andreaux in view of European Patent No. 1263230 ("Cutino"). To the extent that this rejection may still apply to the amended claims, this rejection is respectfully traversed.

As previously discussed, Andreaux does not disclose or render obvious all the limitations of amended independent claim 1. Further, Cutino fails to provide that which Andreaux lacks. For example, Cutino does not disclose or render obvious a counting step such that a memory location stores a count of occurrences of decryption steps. Rather, Cutino, at best, provides a smart card with a loaded monetary value which can be used to make purchases via communications over cable or Internet. *See* Cutino: paragraph [0015]. Because a counter that tracks a monetary value is not the same as a counter which tracks the occurrences of decryption steps, the Applicant asserts that Cutino does disclose or render obvious that which Andreaux lacks.

In view of the above, amended independent claim 1 is patentable over Andreaux and Cutino. Further, dependent claim 4 is patentable for at least the same reasons. Accordingly, withdrawal of this rejection is respectfully requested.

New Claims

Claims 11 and 12 have been added by way of this reply. Support for these claims may be found, for example, in paragraphs [0044]-[0059] and the claims of the originally-filed application. Further, Applicants submit that the newly-added claims do not add any new matter therefore do not necessitate a new search.

Conclusion

Applicant believes this reply is fully responsive to all outstanding issues and places this application in condition for allowance. If this belief is incorrect, or other issues arise, the Examiner is encouraged to contact the undersigned or his associates at the telephone number listed below. Please apply any charges not covered, or any credits, to Deposit Account 50-0591 (Reference Number 09669/081001).

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Respectfully submitted,

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